

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 21, 2005 (the "Office Action"). At the time of the Office Action, Claims 1-57 were pending in the Application. In order to advance prosecution of this case, Applicants amend Claims 1, 3, 4, 6, 7, 20, 22, 25, and 39; cancel Claims 2, 21 and 40; and add new Claims 58-60. Applicants respectfully submit that no new matter has been added. Applicants respectfully request reconsideration and favorable action in this case.

Section 112 Rejections

The Office Action rejects Claims 41-42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of which Applicants regard as the invention. Claims 41-42 depend from Claim 39. As amended, Claim 39 recites generating "a priority certificate" thus providing an antecedent basis for "the priority certificate" recited in Claims 41-42. Applicants therefore respectfully request that the rejection of Claims 41-42 be withdrawn.

Section 102/103 Rejections

The Office Action rejects Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2001/0014095 issued to Kawahata et al. ("*Kawahata*"). The Office Action also rejects Claims 2-7, 21, 22, 25, and 40-42 under 35 U.S.C. § 103(a) as being unpatentable by *Kawahata* in view of U.S. Patent No. 6,745,043 issued to Lester et al. ("*Lester*"). The Office Action additionally rejects Claims 8-20, 23-24, 26-39, and 43-57 under 35 U.S.C. § 103(a) as being unpatentable by *Kawahata*. Applicants respectfully traverse these rejections for the reasons discussed below.

As amended Claim 1 recites:

A method for assigning call priority in a packet switched environment, comprising:
receiving a request to establish a connection to a dialed number;
determining a priority for the connection based on the dialed number;
generating a priority certificate based on the priority;
attaching the priority certificate to the communication packets of the connection; and
establishing the connection based on the priority.

Claim 1 contains elements previously contained within the now canceled Claim 2. With respect to Claim 2 the Office Action states that *Lester* teaches using a priority certificate. *Office Action*, page 3. *Lester* teaches a communication signal having a signal identifier, and the signal identifier is compared to a priority list. *Lester*, column 3, lines 61-67. "The communication signal is then assigned a priority rating based on the comparison of the signal identifier to the priority signal identifiers contained within the priority communication list." *Lester*, column 4, lines 5-8. Nowhere does *Kawahata* or *Lester* disclose, teach or suggest generating a priority certificate based on the priority and attaching the priority certificate to the communication packets of the connection. For example, *Lester* discloses using a signal identifier to assign priority as opposed to attaching a priority certificate to packets. Thus, for at least this reason, Applicants respectfully request that Claim 1 be allowed.

Furthermore, the Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have used a priority certificate in *Kawahata et al* (in place of the TOS info) in view of *Lester et al* in order to promote more efficient processing." *Office Action*, page 3. However, the M.P.E.P. states that "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references" M.P.E.P. §2143.01 (citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)). The Office Action has not provided a proper motivation to combine *Lester* with *Kawahata*. Therefore, for at least this additional reason Applicants respectfully submit that Claim 1 is allowable.

Applicants respectfully submit that Claims 20 and 39 are allowable for reasons analogous to those set forth above with respect to Claim 1.

Claims 3-19 depend either directly or indirectly from Claim 1, Claims 22-38 depend either directly or indirectly from Claim 20 and Claims 41-57 depend either directly or indirectly from Claim 39. Therefore, for at least the reasons sets forth above with respect to

Claims 1, 20 and 39, Applicants respectfully request that the rejection of Claims 3-19, 22-38 and 41-57 be withdrawn.

Moreover, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the art is one that would have found the claim to be obvious in light of the teachings of the references." M.P.E.P. § 706.02(j) (citing *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985)). The Office Action does not meet this requirement. Rather the Office Action asserts, in various different forms, that Claims 3-4 and 6-57 are obvious without citing to any motivation in any reference in support of the assertion.

For example, the Office Action has provided no arguments or assertions in support of the rejection of Claim 5. The Office Action merely states that Claims 2-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawahata* in view of *Lester*. *Office Action*, page 3.

Two more examples can be found with regard to Claims 9 and 10. Claim 9 recites determining whether adequate resources are available for a connection and if not available, pre-empting other connections to free up resources for the connection and establishing the connection using the freed-up resources. Claim 10 further recites that freeing up resources comprises downgrading the quality of service parameters of the other connections. The Office Action contends that "it would be obvious to preempt the other calls in view of the above teachings, and to monitor the endpoints as well." *Office Action*, page 4. Both Claims 9 and 10 recite more than merely preempting other calls (e.g. Claim 9 establishes a connection using freed-up resources from the pre-emption, and Claim 10 downgrades the quality of service of some connections), yet the Office Action does not provide any assertions directed to the additional elements of Claims 9 and 10.

This lack of support for the rejections is repeated for the remainder of Claims 3-4, 6-8 and 11-57, thus Applicants respectfully request that Claims 3-4 and 6-57 be allowed.

To the extent that any rejection is based on "Official Notice," "well-known art," common knowledge or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of his position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104.

According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.'" *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)). Furthermore, while "evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001).

Applicants respectfully submit that the Office Action provides no support for its contentions that Claims 3-4 and 6-57 are obvious. As mentioned above the Office Action has not provided references in support of its obviousness contentions. To the extent that that support can be found for the Office Action's contentions that Claims 3-4 and 6-57 are obvious the Office Action has not provided the requisite suggestion or motivation to combine references nor has it provided the evidence necessary to support a motivation to combine references. Therefore, Applicants respectfully request that Claims 3-4 and 6-57 be allowed.

New Claims

Claims 58 and 59 correspond to Claims 5 and 9 rewritten in independent form, and Claim 60 corresponds to Claim 10 rewritten to depend from Claim 59. Applicants respectfully submit that Claims 58-60 are allowable for the reasons set forth above with respect to Claims 5, 9 and 10. Therefore, applicants respectfully request that Claims 58-60 be allowed.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

A check in the amount of \$400.00 is attached for two additional independent claims. Applicants believe no other fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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